APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,199	01/24/2001	Dennis A. Morgan	MS163086.1	4341

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EXAMINER
DUNCAN, MARC M

ART UNIT	PAPER NUMBER
2113	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	**Applicant(s)**	
Office Action Summary		09/769,199	MORGAN ET AL.	
		Examiner	**Art Unit**	
		Marc M Duncan	2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40,42 and 44-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *39,40 and 42* is/are allowed.

6)☒ Claim(s) *1-2, 12-19, 21-38, 44-46* is/are rejected.

7)☐ Claim(s) *3-11 and 20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claim 31 is rejected under 35 U.S.C. 112, second paragraph.

Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 12, 31, 32, 33, 34, 35, 36, 37, 38, 44, 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Grieco et al.

Claims 13-19 and 21-30 rejected under 35 U.S.C. 102(e) as being anticipated by Worley et al.

Claims 3-11 and 20 are objected to.

Claims 39, 40 and 42 are allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The final two lines of applicant's claim 31 are obviously missing words that make the claim indefinite. It is impossible for the examiner to determine the metes and bounds of the final intended limitation in its current state. The examiner has chosen to examine claim 31 without this final limitation in order to provide a full and complete examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A data packet is not statutory subject matter under 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 12, 31, 32, 33, 34, 35, 36, 37, 38, 44, 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Grieco et al.

Regarding claim 1:

Grieco teaches an interface component that launches a software tool in col. 1 lines 58-61.

Grieco teaches a diagnostic component associated with the local host computer in the networked computer system in col. 2 lines 3-7.

Grieco teaches wherein the diagnostic component obtains first information related to the local host computer when the software tool is launched in col. 2 lines 59-

62 and col. 3 lines 23-28. The interface software must determine the type of test equipment it is communicating with.

Grieco teaches the software tool selectively performs at least one test associated with the local host computer in order to obtain at least one test result according to the first information col. 2 lines 3-7.

Grieco teaches the software tool determines at least one attribute associated with the networked computer system according to at least one of the first information and the at least one test result in col. 2 lines 10-13.

Grieco teaches wherein the software tool selectively provides the at least one attribute to at least one of a transferable file in the local host computer and the interface component in col. 36 lines 17-19.

Regarding claim 2:

Grieco teaches wherein the software tool selectively provides the at least one attribute to the interface component, and wherein the interface component renders the at least one attribute to a user in col. 2 lines 17-19.

Regarding claim 12:

Grieco teaches wherein the diagnostic component and the interface component reside on the local host computer in col. 3 lines 1-4.

Regarding claim 31:

Grieco teaches means for launching a diagnostic software tool using an interface component associated with the diagnostic software tool in col. 1 lines 58-61.

Grieco teaches means for obtaining first information related to a local host

computer in the networked computer system in col. 2 lines 59-62 and col. 3 lines 23-28.

Grieco teaches means for selectively performing at least one test associated with

the local host computer according to the first information in col. 2 lines 3-7.

Grieco teaches means for obtaining at least one test result associated with the at

least one test in col. 2 lines 8-9.

Grieco teaches means for determining at least one attribute associated with the

networked computer system according to at least one of the first information and the at

least one test result in col. 2 lines 10-13.

Regarding claim 32:

Grieco teaches a diagnostic component that:

obtains first information related to a local host computer in col. 2 lines 59-62 and

col. 3 lines 23-28;

selectively performs at least one test associated with the local host computer in

order to obtain at least one test result according to the first information in col. 2 lines 3-

7;

and determines at least one attribute associated with the networked computer

system according to at least one of the first information and the at least one test result in

col. 2 lines 10-13.

Grieco also teaches a remedial object that performs at least one remedial action

according to the at least one attribute in col. 2 lines 13-15.

Regarding claim 33:

Grieco teaches wherein the diagnostic component selectively provides the at least one attribute to at least on of a transferable file in the local host computer and an interface component associated with the local host computer col. 36 lines 17-19.

Regarding claim 34:

Grieco teaches wherein the at least one remedial action comprises determining another attribute associated with the networked computer system according to the at least one attribute using the diagnostic component in col. 2 lines 15-16. A cause of a problem is another attribute of the networked computer system.

Regarding claim 35:

Grieco teaches wherein the diagnostic component determines another attribute associated with the networked computer system after performance of the at least one remedial action in col. 2 lines 15-16. The cause of the problem isn't determined until after the problem compared to the database.

Regarding claim 36:

Grieco teaches an interface component that renders the at least one attribute to a user in col. 2 lines 17-19.

Regarding claim 37:

Grieco teaches an interface component that launches the diagnostic component in col. 1 lines 58-61.

Regarding claim 38:

Grieco teaches wherein the interface component renders information related to the at least one remedial action to the user in col.2 lines 17-19 and col. 36 lines 17-19.

Regarding claim 44:

Grieco teaches a diagnostic object that determines an attribute associated with a

computer system in col. 2 lines 10-13.

Grieco teaches wherein the diagnostic object provides the attribute to at least

one of a file in the computer system and an interface in col. 36 lines 17-19.

Regarding claim 45:

Grieco teaches a diagnostic component that determines at least one attribute

associated with a networked compute system in col. 2 lines 10-13.

Grieco teaches an interface component that launches the diagnostic component

and renders the at least one attribute to a user in col. 1 lines 58-61 and col. 2 lines 17-

19.

Regarding claim 46:

Grieco teaches a diagnostic component that determines at least one attribute

associated with a networked computer system in col. 2 lines 10-13.

Grieco teaches a client side computer having an interface component that

launches the diagnostic component and renders the at least one attribute to a user in

col. 1 lines 58-61 and col. 2 lines 17-19.

Claims 13-19 and 21-30 rejected under 35 U.S.C. 102(e) as being anticipated by

Worley et al.

Regarding claim 13:

Worley teaches launching a diagnostic software tool using an interface

component associated with the diagnostic software tool in col. 4 lines 30-31 and line 43.

Worley teaches obtaining first information related to a local host computer in the

networked computer system in the Abstract lines 16-21.

Worley teaches selectively performing at least one test associated with the local

host computer according to the first information in col. 5 line 56.

Worley teaches obtaining at least one test result associated with the at least one

test in col. 5 line 56. Performing a test inherently includes obtaining a test result.

Worley teaches determining at least one attribute associated with the networked

computer system according to at least one of the first information and the at least one

test result in col. 5 lines 55-59.

Worley further teaches selectively providing the at least one attribute to at least

one of a transferable file in the local host computer and the interface component in col.

7 line 56, col. 8 line 53 and col. 8 lines 58-59.

Regarding claim 14:

Worley teaches wherein selectively providing the at least one attribute to at least

one of a transferable file associated with the local host computer and the interface

component comprises providing the at least one attribute to the interface component,

further comprising rendering the at least one attribute to a user using the interface

component in col. 8 lines 58-59.

Regarding claim 15:

Worley teaches providing the at least one attribute to a transferable file

associated with the local host computer, further comprising sending the transferable file

to another computer associated with the networked computer system in the Abstract lines 9-10.

Regarding claim 16:

Worley teaches obtaining a first data set comprising information relating to at least one of a mail service, news service, Internet service and loopback in col. 9 lines 59-65.

Regarding claim 17:

Worley teaches obtaining a second data set comprising information related to an operating system in col. 5 lines 38-39.

Regarding claim 18:

Worley teaches obtaining a third data set comprising information related to at least one of a modem, a network adapter and an installed client in col. 7 lines 21-24.

Regarding claim 19:

Worley teaches determining the at least one attribute comprises one of querying a data store and verifying a connection in col. 5 lines 38-39 and col. 5 line 56.

Regarding claim 21:

Worley teaches that verifying a connection comprises sending out a packet and waiting for a response in col. 10 line 46.

Regarding claim 22:

Worley teaches that verifying a connection comprises determining an IP address from the response in col. 10 line 46 (this function is inherent).

Regarding claim 23:

Worley teaches that verifying a connection comprises determining whether a particular IP address is online in col. 10 line 46 (this function is inherent).

Regarding claim 24:

The claim is rejected as the computer program product containing instructions for performing the method of claim 13.

Regarding claim 25:

The claim is rejected as the computer program product containing instructions for performing the method of claim 14.

Regarding claim 26:

The claim is rejected as the computer program product containing instructions for performing the method of claim 15.

Regarding claim 27:

The claim is rejected as the computer program product containing instructions for performing the method of claim 16.

Regarding claim 28:

The claim is rejected as the computer program product containing instructions for performing the method of claim 17.

Regarding claim 29:

The claim is rejected as the computer program product containing instructions for performing the method of claim 18.

Regarding claim 30:

The claim is rejected as the computer program product containing instructions for performing the method of claim 19.

Allowable Subject Matter

Claims 3-11 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Prior art was not found that explicitly teaches or fairly suggests the group comprising a first data set corresponding to services associated with the local host computer, a second data set corresponding to computer information and a third data set corresponding to modems and network adapters associated with the local host computer as outlined in claim 3. Prior art was not found that explicitly teaches or fairly suggests querying the computer's registry as outlined in claim 20.

Response to Arguments

Applicant's arguments with respect to claims 1-12, 31-38, 44, 45 and 46 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments concerning claims 13-19, 21-30 and 45, filed 6/9/04, have been fully considered but they are not persuasive.

Regarding applicant's arguments that Worley does not teach a diagnostic component, the examiner respectfully disagrees. Worley teaches running diagnostics, i.e. monitoring various functions and checking network connectivity, on the remote computer using the software interface that powers the hardware tool of Worley.

Applicant's claims 13 and 24 do not in any way teach that the software tool contains a diagnostic component. Applicant's claims 13 and 24 further do not teach that any of the steps of the claimed method are performed automatically by the software tool. A service technician manually launching tests and obtaining information, as applicant contends is occurring in the Worley reference, reads on claims 13 and 24. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's arguments that claim 45 contains statutory subject matter, the examiner respectfully disagrees. Although applicant contends that a data packet is statutory subject matter for the purposes of 35 USC 101, a mere assertion of patentability is not sufficient. While applicant contends that a data packet is directed at computer usage, such an assertion is not sufficient to meet the requirements of 35 USC 101. A data packet remains an abstract idea. A data packet is, furthermore, not a process, machine, manufacture or composition of matter, as required by 35 USC 101. The rejection will not be removed until the claim is either cancelled or amended to meet the requirements of 35 USC 101.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Marc M Duncan whose current telephone number is

703-305-4622. The examiner's telephone number as of October 15th, 2004 will be 571-

272-3646. The examiner can normally be reached on M-T and TH-F 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert Beausoliel can be reached on 703-305-9713. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

md

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